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NO. 2144 P. 1

APR 12 2007

Attorney Docket No.: Enz-61(D12)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Stavrianopoulos et al.

Serial No.: 10/764,417

Group Art Unit: 1637

Filed: January 23, 2004

Examiner: Jezia Riley

For: **PROCESS FOR DETECTING THE PRESENCE OR
QUANTITY OF ENZYMATIC ACTIVITY IN A SAMPLE**

Confirmation No.:

CERTIFICATE OF FACSIMILE TRANSMISSION

Mail Stop -- Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I hereby certify that the attached correspondence (total of 11 pages including this sheet) comprising:

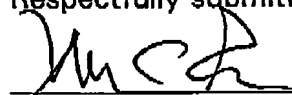
Reply Under 37 C.F.R. §1.143

(To The October 11, 2006 Restriction Requirement) (7 pages); and

Petition For Revival Of An Application For Patent Application Abandoned
Unintentionally Under 37 CFR 1.137(b) (3 pages)

was sent to the United States Patent and Trademark Office by telefax to (571) 273-8300.

Respectfully submitted,



Ronald C. Fedus

Reg. No. 32,567

Attorney for Applicants

Date: April 12, 2007

Enzo Life Sciences, Inc.
c/o Enzo Biochem, Inc.
527 Madison Avenue, 9th Floor
New York, NY 10022-4304
Telephone (212) 583-0100
Facsimile (212) 583-0150

Enz-61(D12)

APR 12 2007

PTO/SB/64 (09-06)

Approved for use through 03/31/2007. OMB 0851-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**Docket Number (Optional)
Enz-61(D12)

First named inventor: Jannis G. Stavrianopoulos et al.

Application No.: 10764,417

Art Unit: 1637

Filed: January 23, 2004

Examiner: Jezia Riley

Title: PROCESS FOR DETECTING THE PRESENCE OR QUANTITY OF ENZYMATIC ACTIVITY IN A SAMPLE

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

- ☒ Small entity-fee \$ 750.00 (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.##
- ☐ Other than small entity - fee \$ _____ (37 CFR 1.17(m))

2. Reply and/or fee

- A. The reply and/or fee to the above-noted Office action in the form of Response Under 37 C.F.R. 1.143 (identify type of reply):

- ☐ has been filed previously on _____.
- ☒ is enclosed herewith.

04/13/2007 NNGUYEN1 00000119 051135 10764417

- B. The issue fee and publication fee (if applicable) of \$ 01 FC:2453 750.00 DA

- ☐ has been paid previously on _____.
- ☐ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Please charge the \$750.00 small entity fee to Deposit Account NO. 05-1135.

PTO/SB/64 (09-06)

Approved for use through 03/31/2007. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

3. Terminal disclaimer with disclaimer fee

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.



Signature

April 12, 2007

Date

Ronald C. Fedus

Typed or printed name

32,567

Registration Number, if applicable

Enzo Life Sciences, Inc. c/o Enzo Biochem, Inc.

Address

(212) 583-0100

Telephone Number

527 Madison Avenue, 9th Floor, New York, NY 10022-4304

Address

Enclosures: ☒ Fee Payment☒ Reply☐ Terminal Disclaimer Form☐ Additional sheets containing statements establishing unintentional delay☒ Other, Facsimile Transmittal Form**CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]**

I hereby certify that this correspondence is being:

- ☐ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.
- ☒ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

April 12, 2007

Date



Signature

Ronald C. Fedus

Typed or printed name of person signing certificate

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

APR 12 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Stavrianopoulos et al.
Serial No.:	10/764,417
Filed:	January 23, 2004
For:	PROCESS FOR DETECTING THE PRESENCE OR QUANTITY OF ENZYMATIC ACTIVITY IN A SAMPLE

Group Art Unit: 1637

Examiner: Jezia Riley

527 Madison Avenue (9th Floor)
New York, NY 10022-4304
April 12, 2007**FILED BY FACSIMILE TRANSMISSION**
TO: (571) 283-8300Mail Stop -- Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**REPLY UNDER 37 C.F.R. §1.143**
(TO THE OCTOBER 11, 2006 RESTRICTION REQUIREMENT)

Dear Sirs:

This paper (Reply Under 37 C.F.R. §1.143) is in response to the Office Communication and restriction requirement mailed on October 11, 2006 in connection with the above-identified application. The deadline for responding to the October 11, 2006 Office Communication was originally November 11, 2006. This paper (Reply Under 37 C.F.R. §1.143) is accompanied by Applicants' Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 C.F.R. §1.137(b) and authorization for the small entity fee therefor. Upon granting of Applicants' Petition, this paper (Reply Under 37 C.F.R. §1.143) will be considered.

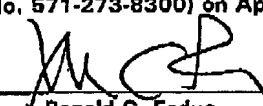
Enz-61(D12)

Jannis G. Stavrianopoulos et al.

Serial No.: 10/764,417

Filed: January 23, 2004

Page 2 [Reply Under 37 C.F.R. §1.143 (To The October 11, 2006 Restriction Requirement) -- April 12, 2007]

CERTIFICATE OF TRANSMISSION	
I hereby certify that this paper (Reply Under 37 C.F.R. §1.143 (To The October 11, 2006 Restriction Requirement) (along with any documents referred to as attached or enclosed) is being facsimile transmitted to the Commissioner for Patents, United States Patent and Trademark Office (Fax No. 571-273-8300) on April 12, 2007.	
APR 12 2007 Date	 Ronald C. Fedus Reg. No. 32,567

Change the title of the invention to:

-- FLUORESCENT DYE COMPOSITION AND TARGET
LABELED THEREWITH -- .

Enz-61(D12)

Jannis G. Stavrianopoulos et al.

Serial No.: 10/764,417

Filed: January 23, 2004

Page 3 [Reply Under 37 C.F.R. §1.143 (To The October 11, 2006 Restriction Requirement) -- April 12, 2007]

REMARKS

No claims have been amended, added or canceled by this paper which is a response to the October 11, 2006 Office Communication. A new title of the invention has been added. The new title is believed to reflect better the subject matter of the pending claims in this application.

In the October 11, 2006 Office Communication (page 2), it is stated that restriction is required to one of the following two inventions under 35 U.S.C. §121:

- I. Claims 287-306, drawn to a dye composition, classified in class 546, subclass 16, 270.
- II. Claims 307-321, drawn to a labeled target, classified in class 536, subclass 26.6.

According to the Office Communication (pages 2-3), the inventions are distinct, each from the other because of the following reasons:

Inventions I and II are directed to related compositions. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP §806.05(j). In the instant case, the inventions as claimed design. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143)

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Jannis G. Stavrianopoulos et al.

Serial No.: 10/764,417

Filed: January 23, 2004

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and (U) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.170).

Applicants respectfully traverse the restriction requirement and ask that it be withdrawn upon further reconsideration.

In response, Applicants hereby provisionally elect, with traverse, the invention of Group I, claims 287-306, drawn to a dye composition. Applicants respectfully request reconsideration and withdrawal of the restriction requirement in view of the remarks set forth below.

At the outset, Applicants are mindful that this application is a divisional of and claims priority to U.S. Patent Application Serial No. 10/096,075, filed on March 12, 2002, and that a Preliminary Amendment was filed on January 23, 2004 presenting all of claims 287-321. The presentation of claims 287-321 was made in direct response to an earlier restriction requirement made in the January

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Jannis G. Stavrianopoulos et al.

Serial No.: 10/764,417

Filed: January 23, 2004

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14, 2004 Office Action issued in connection with the priority application, Serial No. 10/096,075. In the January 14, 2004 Office Action, restriction was required to one of thirteen different inventions including:

Group XIII Claims 252-286, drawn to a dye and labeled target with same, classified in class 546 subclass 16, class 430, subclass 93.

The present application, Serial No. 10/764,417, is the twelfth divisional application in the family and contains claims 287-321 which correspond directly to claims 252-286 in the aforementioned Group XIII as set forth in the January 14, 2004 Office Action. If Applicants had known at the time of filing this divisional application that further restriction were to be made more than three years later for claims 287-321 (corresponding to claims 252-286 in Group XIII), they and their attorney would have most likely filed one additional divisional and thereby avoid the loss of time and prosecution costs now being presently incurred.

Applicants respectfully request that reconsideration be given to the present restriction requirement in light of the earlier January 14, 2004 restriction requirement to which responses and reliance have been made for more than three years.^{1 2}

¹ It should also be noted that three U.S. patents have already been issued following the earlier restriction requirement made on January 14, 2004. These include:

U.S. Patent No. 7,166,478 B2 that issued on January 23, 2007 from the aforementioned priority application, Serial No. 10/096,075, filed on March 12, 2002;

U.S. Patent No. 7,163,796 B2 that issued on January 16, 2007 from divisional application Serial No. 10/764,418, filed on January 23, 2004; and

U.S. Patent No. 6,949,659 B2 that issued on September 27, 2005 from divisional application Serial No. 10/764,393, also filed on January 23, 2004.

The latter two '796 and '949 patents and applications correspond to the eleventh and seventh divisional filings in the family.

² With respect to the aforementioned U.S. Patent No. 7,166,478 B2, it should be noted that claims 1-13 issued for a labeling reagent, and claims 14-20 issued for a process for labeling a target. Again, such issued claims corresponded to the January 14, 2004 restriction requirement.

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Jannis G. Stavrianopoulos et al.

Serial No.: 10/764,417

Filed: January 23, 2004

Page 6 [Reply Under 37 C.F.R. §1.143 (To The October 11, 2006 Restriction Requirement) -- April 12, 2007]

In addition, Applicants respectfully offer the remarks below.

Under M.P.E.P. §803, two criteria are necessary in order for a restriction requirement between patentably distinct inventions to be proper:

- 1) The inventions must be independent or distinct as claimed; and
- 2) There must be a serious burden on the Examiner if restriction is not required.

The claims represented by Groups I-II form a single general inventive concept which should be properly examined in the same application. As set forth in the earlier January 14, 2004 restriction requirement, the dye and the labeled target are inextricably related by virtue of the fact that the dye recited in claims 287-306 is used to make the labeled target recited in claims 307-321. The fact that the dye defined by claims 287-306 are related to the labeled target of claims 307-321 should mitigate against any inference that a serious burden would be placed on the search and examination efforts if restriction is not required.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the present restriction requirement. Examination of all the claims, 287-321, is respectfully urged and is believed to be appropriate given the earlier restriction in the priority application as described above.

* * * * *

Enz-61(D12)

Jannis G. Stavrianopoulos et al.

Serial No.: 10/764,417

Filed: January 23, 2004

Page 7 [Reply Under 37 C.F.R. §1.143 (To The October 11, 2006 Restriction Requirement) -- April 12, 2007]

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SUMMARY AND CONCLUSIONS

This paper (Reply Under 37 C.F.R. §1.143) is responsive to the October 11, 2007 Office Communication and restriction requirement. A new title of the invention has been added.

Because no new claims have been added and because this paper (Reply Under 37 C.F.R. §1.143) is being filed with a Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 C.F.R. §1.137(b). The small entity fee for filing the Petition is \$750.00 under 37 C.F.R. §1.17m. The Patent and Trademark Office is hereby authorized to charge the amount of \$750.00 to Deposit Account No. 05-1135. No other fee or fees are believed due in connection with this paper. In the event that any fee(s) is/are due, however, The Patent and Trademark Office is hereby authorized to charge the amount of any such other fee(s) to Deposit Account No. 05-1 135, or to credit any overpayment thereto.

Applicants respectfully request early examination of claims 287-321.

Early and favorable action is respectfully requested.

Respectfully submitted,



Ronald C. Fedus
Registration No. 32,567
Attorney for Applicants

ENZO LIFE SCIENCES, INC.
c/o ENZO BIOCHEM, INC.
527 Madison Avenue, 9th Floor
New York, NY 10022-4304
Telephone: (212) 583-0100
Facsimile: (212) 583-0150

Enz-61(D12)